



PATENT APPLICATION

DEF/REF
#307
\$

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Horikoshi MAMORU et al

Appln. No.: 09/508,418

Group Art Unit: 1652

Filed: June 8, 2000

Examiner: Steadman, D.

For: **NOVEL PROTOPORPHYRINOGEN OXIDASE TOLERANT
TO PHOTBLEACHING HERBICIDE**

#15

REQUEST FOR REFUND

Assistant Commissioner
of Patents
Washington, D.C. 20231

Sir:

Applicants hereby respectfully request a refund in the amount of \$390.00, for the above-identified application.

Specifically, on April 11, 2001, Applicants filed an Election in response to the Office Action (Restriction Requirement) of January 11, 2001 (Paper No. 10), for which reply was due within the indicated response time of three months (a copy of the Action and date-stamped mailroom receipt is attached hereto). Therefore, Applicants did file a timely response.

However, Applicants' Deposit Account was charged the fee for a two-month's extension of time, i.e., in the amount of \$390.00, as indicated on the Monthly Statement of Deposit Account dated April 30, 2001 (a copy of which is attached hereto).

Hence, Applicants timely filed a response to the Official Action of January 11, 2001, and no extensions of time were needed. Therefore, Applicants respectfully request that a refund (in the amount of \$390.00) be restored to Deposit Account No. 19-4880. A duplicate copy of this paper is attached for such purpose.

**SUGHRUE, MION, ZINN,
MACPEAK & SEAS, PLLC**
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202
Telephone: (202) 293-7060
Facsimile: (202) 293-7860
Date: July 18, 2001

Respectfully submitted,

Drew Hissong
Registration No. 44,765



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

MONTHLY STATEMENT
OF DEPOSIT ACCOUNT

To replenish your Deposit Account, detach and return top portion with your check. Make check payable to Commissioner of Patents & Trademarks.

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Account No.	194880
Date	4-30-01
Page	3

SUGHRUE MION ZINN MACPEAK & SEAS

FINA

2100 PENNA AVE N W
SUITE 800
WASHINGTON DC 20037

PLEASE SEND REMITTANCES TO:
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DATE POSTED			CONTROL NO.	DESCRIPTION (Serial, Patent, TM, Order)	DOCKET NO.	FEE CODE	CHARGES/ CREDITS	BALANCE
MO.	DAY	YR.						
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4	10	01	45	1511110	11878099	465	30.00	49496.82
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4	11	01	1	75444503		364	600.00	48696.82
4	11	01	2	LIBBY MICHAEL		636	300.00	48396.82
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4	11	01	110	911014		372	100.00	45984.82
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4	11	01	133	09139332	Q51458	119	310.00	45274.82
4	12	01	1	09497516	Q57818	102	160.00	45114.82
4	12	01	1	09163912	Q51643	102	80.00	45034.82
4	12	01	2	09457674	Q56766	102	80.00	44954.82
4	12	01	76	09095895	Q48316	131	710.00	44244.82
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4	12	01	136	395430		569	25.00	44109.82
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4	13	01	5	09688787	Q61107	105	130.00	43264.82
4	13	01	6	09697160	Q058501	103	414.00	42850.82
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4	13	01	77	09116458	Q51088	117	890.00	41810.82
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4	16	01	19	09807380	Q64060	966	18.00	40752.82
4	16	01	20	09807381	Q64002	970	860.00	39892.82
4	16	01	22	75671674	S-1315	364	150.00	39742.82

AN AMOUNT SUFFICIENT TO
COVER ALL SERVICES REQUESTED
MUST ALWAYS BE ON DEPOSIT.

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TOTAL CREDITS

CLOSING BALANCE



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/508,418	06/08/00	HORIKOSHI	M 058140

SUSHRUE MION ZINN
MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20037

HM12/0111

EXAMINER

KRUSE, D

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

01/11/01

DOCKETED
JAN 12 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

DOCKETING

03:49 PM JAN 15 2001

PROCESSING

HOB

Office Action Summary

Application No.

09/508,418

Examiner

David H Kruse

Applicant(s)

HORIKOSHI ET AL.

Art Unit

1638

Applicant's Copy

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a protoporphyrinogen oxidase or a mutant peptide having protoporphyrinogen oxidase activity that is tolerant to a photobleaching herbicide.

Group II, claim(s) 9-26, drawn to a gene encoding a protoporphyrinogen oxidase or a mutant peptide having protoporphyrinogen oxidase activity that is tolerant to a photobleaching herbicide, a recombinant vector comprising said gene and a transformant produced by said vector.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Modified forms of the protoporphyrinogen oxidase enzyme that are tolerant to a photobleaching herbicide were known in the art at the time of Applicant's invention (see WO 97/32011, Volrath *et al*, abstract only). Thus, under PCT Rule 13.2 there is no special technical feature among the inventions nor a single inventive concept as required under PCT Rule 13.1.

Art Unit: 1638

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

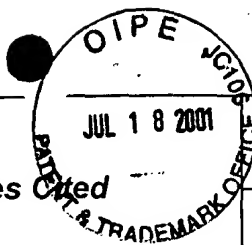
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Paula Hutzell can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1234.



AMY J. NELSON, PH.D
PRIMARY EXAMINER

David H. Kruse, Ph.D.
5 January, 2001



Notice of References Cited	Application/Control No. 09/508,418	Applicant(s)/Patent Under Reexamination HORIKOSHI ET AL.	
	Examiner David H Kruse	Art Unit 1638	Page 1 of 1

U.S. PATENT DOCUMENTS								
*		DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
							APS	OTHER
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FOREIGN PATENT DOCUMENTS									
*		DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS	DOCUMENT SOURCE **	
								APS	OTHER
<input type="checkbox"/>	N	WO 97/32011 <i>Abstract only</i>	Sep. 1997	WO	Volrath et al	435	189	<input checked="" type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	O							<input type="checkbox"/>	<input type="checkbox"/>
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NON-PATENT DOCUMENTS				
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			APS	OTHER
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<input type="checkbox"/>	W		<input type="checkbox"/>	<input type="checkbox"/>
<input type="checkbox"/>	X		<input type="checkbox"/>	<input type="checkbox"/>

*A copy of this reference is not being furnished with this Office action. (See Manual of Patent Examining Procedure, Section 707.05(a).)

**APS encompasses any electronic search i.e. text, image, and Commercial Databases.

PCTWORLD INTELLECTUAL PROPERTY ORGANIZATION
International Bureau

INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(51) International Patent Classification 6 : C12N 9/02, 15/82	A1	(11) International Publication Number: WO 97/32011 (43) International Publication Date: 4 September 1997 (04.09.97)
(21) International Application Number: PCT/US97/03313 (22) International Filing Date: 27 February 1997 (27.02.97) (30) Priority Data: 60/012,705 28 February 1996 (28.02.96) US 60/013,612 28 February 1996 (28.02.96) US 60/020,003 21 June 1996 (21.06.96) US (71) Applicant (for all designated States except US): NOVARTIS AG [CH/CH]; Schwarzwaldallee 215, CH-4058 Basel (CH). (72) Inventors; and (75) Inventors/Applicants (for US only): VOLRATH, Sandra, L. [US/US]; 4225 Pine Oak Drive, Durham, NC 27707 (US). JOHNSON, Marie, A. [US/US]; 408 Heather Drive, Raleigh, NC 27606 (US). POTTER, Sharon, L. [US/US]; 3837 Whispering Branch Road, Raleigh, NC 27613 (US). WARD, Eric, R. [US/US]; 3003 Montgomery Street, Durham, NC 27705 (US). HEIFETZ, Peter, B. [US/US]; 3916 Sturbridge Drive, Durham, NC 27713 (US). (74) Agent: MEIGS, J., Timothy; 520 White Plains Road, Tarrytown, NY 10591-9005 (US).		(81) Designated States: AU, BA, BB, BG, BR, BY, CA, CN, CU, CZ, FI, GE, GH, HU, JP, KG, KR, KZ, LC, LK, LV, MD, MG, MN, MW, NO, NZ, PL, RO, RU, SD, SK, TJ, UA, US, UZ, VN, YU, European patent (AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, ML, MR, NE, SN, TD, TG). Published <i>With international search report.</i> <i>Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.</i>
(54) Title: DNA MOLECULES ENCODING PLANT PROTOPORPHYRINOGEN OXIDASE AND INHIBITOR-RESISTANT MUTANTS THEREOF (57) Abstract The present invention provides novel DNA sequences coding for plant protoporphyrinogen oxidase (protox) enzymes from soybean, wheat, cotton, sugar beet, grape, rice and sorghum. In addition, the present invention teaches modified forms of protox enzymes that are herbicide tolerant. Plants expressing herbicide tolerant protox enzymes taught herein are also provided. These plants may be engineered for resistance to protox inhibitors via mutation of the native protox gene to a resistant form or they may be transformed with a gene encoding an inhibitor-resistant form of a plant protox enzyme.		